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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,292	06/12/2001	Takahisa Shirakawa	F-11210	3055

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EXAMINER

DALENCOURT, YVES

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/878,292

**Applicant(s)**

SHIRAKAWA, TAKAHISA

**Examiner**

Yves Dalencourt

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 15 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-8 and 15 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This office action is responsive to amendment filed on 06/03/2005.

#### ***Election/Restrictions***

Claims 9 – 14 were withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11/01/2004. Thus, Applicant is kindly requested to cancel claims 9 – 14.

#### ***Response to Amendment***

The examiner has acknowledged the amended drawings, the amended specification, and the amended claims 1 – 2, and the submission of new claim 15.

#### ***Response to Arguments***

Applicant's arguments filed 06/03/2005 have been fully considered but they are not persuasive.

Applicant argues that according to the claimed invention, there is no listing of possible interactions and conversions of an electronic mail address of the transmission source is performed without being based on the list of possible interaction (page 14, third paragraph). However, such argument is moot since claim 1 is not as specific as argued by the Applicant. Applicants are reminded that the examiner is entitled to the broadest reasonable interpretation of the claims. It is the claims that define the claimed

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invention, and it is claims, not specifications that are anticipated or unpatentable. The Applicants always have the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater 162 USPQ 541, 550-51 (CCPA 1969).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 15 recite the limitation " the electronic mail address " in lines 5 and 6. There is insufficient antecedent basis for this limitation in the claim. An electronic mail address has not previously been addressed.

Claims 2 – 8 are necessarily rejected as being dependent upon the rejection of claim 1.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 4, 6 – 8, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Dickie et al (US 6,643,687).

Regarding claim 1, Dickie teaches an electronic mail transfer device for relaying an electronic mail transmitted from a transmission terminal through a communication line and transferring the electronic mail thus relayed to a reception terminal (fig. 5; col. 5, lines 3 – 14; Dickie discloses a client component 410 and a server component 420 communicate in a cooperative manner to send and receive email), comprising means for converting to another electronic mail address the electronic mail address of the transmission source of the electronic mail which is transmitted from said transmission terminal through said communication line to another electronic mail address by combining electronic mail address and information appending to the electronic mail, which is varied with every transmission destination and then transferring the electronic mail to said reception terminal (col. 5, lines 12 – 22 and lines 54 – 62; col. 6, lines 17 – 23; Dickie discloses a proxy email address corresponding but not equivalent to the actual email of the sender, may be presented to the recipient for replying to the email message); and means for converting the address of a transmission destination of a reply electronic mail to the address of the transmission source before the address conversion and then transferring the reply electronic mail to said transmission terminal when the reply electronic mail to the electronic mail is transmitted from said reception terminal (col. 5, lines 14 – 34; col. 6, lines 13 – 17; Dickie discloses that an email address is generated by the email system 400 that is a proxy address for sending an email to a recipient from the sender. The proxy email address corresponds to the

recipient's actual email address. Dickie further discloses that there is a separate email address generated for each sender and recipient pair).

Regarding claim 2, Dickie teaches the electronic mail transfer device of claim 1, which further comprising: means for storing the electronic mail address of the transmission source of the electronic mail transmitted from said transmission terminal and the information appending to the electronic mail in a memory while the electronic mail address and the information are associated with each other (col. 5, lines 3 – 42; col. 6, lines 10 – 25; Dickie discloses that server system 40 is coupled to a storage element 230 for storing a database 430 of the proxy addresses for each sender recipient pair; and means for referring to said memory and extracting the electronic mail address of the transmission source of the electronic mail transmitted from said transmission terminal on the basis of the information appending to a reply electronic mail transmitted from said reception terminal (col. 5, lines 3 – 42; col. 6, lines 10 – 25; Dickie discloses that server system 40 is coupled to a storage element 230 for storing a database 430 of the proxy addresses for each sender recipient pair).

Regarding claim 3, Dickie teaches the electronic mail transfer device of claim 1, wherein the another electronic mail address contains the address allocated to said electronic mail transfer device (col. 5, lines 14 – 24; Dickie discloses the proxy address generated by the email system 400 that is a proxy address for sending an email to a recipient from the sender).

Regarding claim 4, Dickie teaches the electronic mail transfer device of claim 2, wherein the information appending to the electronic mail is a header of the electronic

mail (col. 4, lines 1 – 7; col. 5, lines 25 – 30; Dickie discloses a proxy email address generated such as userid@mailsystem.ext or xx12789@serversystem.ext, where “userid or xx12789” is the header as claimed, that identifies that the email message for the project manager was originated by the particular project member).

Regarding claim 6, Dickie teaches the electronic mail transfer device of claimed in claim 1, which further comprises a transmission terminal for transmitting an electronic mail to said electronic mail transfer device (col. 5, lines 25 – 34; Dickie discloses that the email sent from the project member to the project leader is routed to server system 40 where software residing on server system 40 determines that the email address xx12789@serversystem.ext is to be mapped into the recipient's actual email address and forwarded on to the recipient); and a reception terminal for receiving an electronic mail transmitted from said electronic mail transfer device (col. 5, lines 25 – 34; Dickie discloses that the email sent from the project member to the project leader is routed to server system 40 where software residing on server system 40 determines that the email address xx12789@serversystem.ext is to be mapped into the recipient's actual email address and forwarded on to the recipient).

Regarding claim 7, Dickie teaches the electronic mail transfer device of claimed in claim 1, which further comprises a transmission terminal for transmitting an electronic mail through a communication line to said electronic mail transfer device (col. 2, lines 60 – 62; col. 3, lines 3 - 21).

Regarding claim 8, Dickie teaches the electronic mail transfer device of claimed in claim 1, which further comprises a reception terminal for receiving an electronic mail

transmitted from said electronic mail transfer device through a communication line (col. 2, lines 60 – 62; col. 3, lines 3 - 21).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dickie et al (US 6,643,687) in view of Balijepalli et al (US 20004/0230566; hereinafter Balijepalli).

Regarding claim 5, Dickie teaches substantially all the limitations, including a database entry for the recipient's proxy email address that includes a counter, which can be incremented or decremented in order to limit the number of email exchanges for the proxy email address (col. 6, lines 55 – 65; paragraph bridging col. 6, line 65 through col. 7, line 2), but fails to specifically teach the idea of canceling the information appending to the electronic mail from said memory when the number of reply electronic mails exceeds a predetermined number.

However, Balijepalli teaches, in an analogous art, a web-based customized information retrieval and delivery method and system, which comprises means for canceling the information appending to the electronic mail from said memory when the number of reply electronic mails exceeds a predetermined number (paragraph 0031;



Balijepalli discloses that if the reply message is sent (indicating unsuccessful delivery of the message), e.g. 3 times in a row, the corresponding account is suspended and email messages are no longer delivered thereto).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Dickie's device by canceling the information appending to the electronic mail from said memory when the number of reply electronic mails exceeds a predetermined number as evidenced by Balijepalli (see paragraph [0031]. One having ordinary skill in the art would have been motivated to use the teachings of Dickie, wherein the database entry for the recipient's proxy email address would include a counter, which can be incremented or decremented in order to limit the number of email exchanges for the proxy email address (col. 6, lines 55 – 65; paragraph bridging col. 6, line 65 through col. 7, line 2), with the teachings of Balijepalli by providing the use of suspending automatically the electronic delivery of information to electronic mail destination having invalid electronic mail addresses for the purpose of preventing future communication with such electronic mail addresses; thereby providing an enhanced and reliable delivery information system.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

#### **Contact Information**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yves Dalencourt whose telephone number is (571) 272-3998. The examiner can normally be reached on M-TH 7:30AM - 6: 00PM.

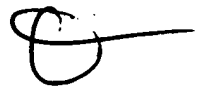
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yves Dalencourt

  
August 12, 2005

  
ABDULLAH SALAS  
Primary Examiner